

AMENDMENTS TO THE DRAWINGS

The attached sheets of drawings include changes to FIG. 7. The replacement sheet, which includes FIGS 6, 7 and 8, replaces the previously submitted and entered sheet including FIGS. 6, 7 and 8. Changes incorporated in the replacement sheet are indicated in red on the attached annotated copy of the previously submitted sheet.

Attachments: Replacement Sheet

Annotated Copy of Original Sheet

REMARKS

Claims 17-20 are cancelled in light of the previous Restriction Requirement. Claims 13-16 are now also cancelled. No new claims are added. Therefore, claims 1-12 remain in this application.

Drawing Objections

The drawings stand objected to because Applicant has not indicated the appropriate cross-hatching for the cutaway section of the rail in FIG. 7. Applicant has amended FIG. 7 to show the metal wires and plastic portion of the rail with the appropriate cross-hatching. Support for this amendment is found in Paragraph [0019] of the specification. Applicant believes that new FIG. 7 overcomes this particular objection and respectfully requests reconsideration of this objection.

35 U.S.C. § 103 Rejections

Claims 1-12 stand rejected under 35 U.S.C. §103(a) for obviousness over the previously cited Safe-Fence reference (hereinafter "Safe-Fence") in view of U.S. Patent No. 5,661,878 to Johnson.

The Examiner has acknowledged that Safe-Fence does not disclose two slots of a slotted connector being within the same planar surface of the slotted connector. The Examiner now contends that it would have been obvious to one of ordinary skill in the art to modify the Safe-Fence invention to include the buckle disclosed in the Johnson patent because use of the Johnson buckle provides a buckle which can be "manufactured more simply, more economically, and with good reliability."

Applicant asserts that these are unpersuasive motivations for combining the buckle taught in the Johnson patent with the teachings of the Safe-Fence invention. First, the Johnson buckle is used in a non-analogous art area (*See* MPEP 2141.01(a)). The disclosure in the Johnson patent is not a "fencing system" and neither teaches nor suggests any

application of the buckle to a fencing system. The Johnson buckle is intended for use in a strapping system to secure a box or other package (*See* column 1, lines 55-57).

It is accepted law that in order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art (*See In re Royka*, 490 F.2d 981, (CCPA 1974)). Neither the Safe-Fence nor the Johnson references teach or suggest the rail with two metal wires ensheathed in a plastic web, as required by the limitations of claim 1. Such a proposed combination would simply not result in all elements of the claimed invention being met.

Furthermore, assuming *arguendo*, that the Safe-Fence device can be combined with or modified in light of the Johnson buckle, it has been held that the ability to combine or modify does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (*See In re Mills*, 916 F.2d 680 (Fed. Cir. 1990); MPEP 2143.01(III)). There is simply no desirability to combining the Johnson buckle with the Safe-Fence device. Specifically, the buckle is disclosed as being constructed of plastic or hard rubber (*See* column 1, line 58). Use of a plastic buckle (of insufficient strength) or rubber buckle in the Safe-Fence invention would result in the buckle easily breaking under tension or rotting, respectively. Furthermore, as previously pointed out, the webbing disclosed in Safe-Fence cannot be retained in a squared, slotted, buckle such as that of the Johnson patent.

Thus, although the Johnson buckle may be "manufactured more simply, more economically, and with good reliability," this qualification is irrelevant, as the Johnson buckle is not suitable for use in a fencing system. This qualification provides no reasonable motivation for combination of the Johnson buckle with the teachings of the Safe-Fence invention. Instead, it would appear that simply bending a rod to form the Safe-Fence device would clearly be a more simple and economical process than stamping or extruding the Johnson buckle (*See* column 1, lines 58-60; column 2, lines 15-18). Accordingly, Applicant

believes that the Examiner is using impermissible hindsight reconstruction to piece together the present invention using a reference from a non-analogous art area and which does not show any reasonable motivation for combination. Such hindsight reconstruction has been deemed to be impermissible.

Specifically, the Federal Circuit has addressed the unacceptable use of hindsight reconstruction as a basis for obviousness rejections in In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992) wherein the Court stated "[i]t is impermissible to use the claimed invention as an instructional manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'" Moreover, in Texas Instruments Inc. v. U.S. Intern. Trade Com'n., 988 F.2d 1165, 1178, 26 USPQ2d 1018, 1029 (Fed. Cir. 1993), the Court stated the prior art "references in combination do not suggest the invention as a whole claimed in the ...patent. *Absent such suggestion to combine the references, respondents can do no more than piece the invention together using the patented invention as a template. Such hindsight reconstruction is impermissible.*" (emphasis added) Furthermore, the most recent Court of Appeals for the Federal Circuit ruling (*Teleflex Inc. v. KSR Int'l. Co.*, 04-1152, Fed. Cir. 2005) regarding the test for obviousness emphasized that the correct standard for obviousness determination requires "*specific findings* showing a teaching, suggestion, or motivation to combine prior art teachings in the particular manner" as set forth in the claims. (emphasis added) There is simply no such teaching, suggestion, or motivation, specific or otherwise, in either of the Johnson or Safe-Fence references.

Again, just because the buckle disclosed in the Johnson patent can be "manufactured more simply, more economically, and with good reliability," is insufficient for purposes of establishing why the teachings of the Johnson patent and Safe-Fence are to be

combined. It is inconceivable how one could simply “modify” the Safe Fence device to make it like the buckle in Johnson. Safe-Fence is a bent rod, whereas Johnson is a stamped or extruded piece of plastic or rubber with squared edges. It has been held that if a proposed combination would require a substantial reconstruction and redesign of the primary reference, as well as a change in the basic principle under which the primary reference operates, then the references do not render the invention prima facie obvious (*See In re Ratti*, 270 F.2d 810 (CCPA 1959); MPEP 2143.01(VI)).

Applicant would like to point out some additional differences between the prior art and the present invention. First, it is important to note that the slotted connector of the present invention includes closed slots, which is important to the installation aspects of securing the rail into the slotted connector. As discussed in the previous response, the Safe-Fence connector is an open-ended bent rod (i.e., lacking any closed slots). As depicted in the Safe-Fence “Installation - Directions and Tips” page of the disclosure, a looped portion of the polytape is slipped onto the open end of the bent rod. This is contrary to the installation of the rail of the present invention, wherein the rigid rail is inserted into each of the closed slots by manually deforming the rail in a step-by-step process (*See* FIGS. 9-12).

With respect to the Johnson buckle, a critical feature thereof would not be necessary for implementing the present invention. Specifically, the Johnson buckle includes vertical legs (3,5) that have roughened surfaces. These surfaces are for the purpose of securely holding the strap when it is threaded through the buckle by providing greater frictional force (*See* column 2, lines 1-7). The present invention does not require any roughened surfaces, as the manual deformation of rigid rail in combination with the high degree of stiffness of the rail (*See* Paragraph [0019]) allows the rail to stay within the slotted connector without the need for any friction engaging roughened surfaces or similar

implements. This is further evidence that it would not be reasonable to combine the Johnson buckle with the Safe-Fence device to obtain the claimed invention.

Based upon the above arguments and consideration of the relevant case-law, Applicant therefore maintains that claim 1 and claims 2-12 depending therefrom are novel and non-obvious in light of the prior art of record. Accordingly, Applicant respectfully requests allowance of all pending claims.

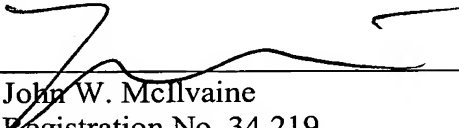
CONCLUSION

Based on the foregoing amendments and remarks, reconsideration of the rejections and allowance of pending claims 1-12 are respectfully requested.

Respectfully submitted,

THE WEBB LAW FIRM

By



John W. McIlvaine
Registration No. 34,219
Attorney for Applicant
700 Koppers Building
436 Seventh Avenue
Pittsburgh, PA 15219
Telephone: 412-471-8815
Facsimile: 412-471-4094
E-mail: webblaw@webblaw.com